

REMARKS/ARGUMENTS

By this Amendment Claims 1, 17, 18 and 19 have been amended. Claims 1-5 and 7-19 are pending.

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

Claims 1 - 3 and 7 - 19 stand rejected as being obvious over U.S. Patent No. 206,387 (Bowen) in view of U.S. Patent No. 4,572,875 (Gutshall), while Claims 4 and 5 are rejected as being obvious over Bowen in view of U.S. Patent No. 4,955,807 (Chance)

Moreover, Claim 1 has been amended to state that the head member is biased (as previously drafted Claim 1 called for the head member to be biased). Support for this amendment resides at paragraph 1, page 3.

For the reasons set forth below it is respectfully submitted that the rejection of the claims on the basis of Bowen in view of either Gutshall or Chance is untenable.

Regarding the rejection of Claim 1 and the claims depending from it, it is not disputed that Bowen teaches an artificial plant having a stalk or trunk member and blooms of a flower or plant connected by a spirally curved wire. Moreover, Bowen does teach the use of a tapering projection pin to use to connect the stalk to the bloom. However, and quite significantly the tapering projection pin is not threaded as required by Claim 1 as currently amended or as previously presented. To overcome this deficiency of the prior art, the PTO cited the Gutshall patent, alleging it would be obvious to utilize the teachings of Gutshall to modify the structure of Bowen to arrive at the claimed subject matter. In particular, while Gutshall discloses a method for manufacturing thread-forming screws and also provides an improved screw blank he does not

teach or suggest the use of his screw in any kind of structure like that set forth in Claim 1. Gutshall merely discloses the manufacture of self-tapping screws which cut material from a bore when driven into the bore. It is respectfully submitted that the combination of Bowen and Gutshall is not tenable to reject Claim 1.

First, Bowen and Gutshall come from different and entirely unrelated fields. The person skilled in the art of garden ornament manufacture when faced with the teaching of Bowen would not turn to the field of manufacturing screws from blanks in order to modify Bowen. Therefore, the combination of Bowen and Gutshall is not a valid basis for an obviousness objection. Moreover, Gutshall does not provide any incentive or direction to use a screw thread of the type disclosed therein in the field of garden ornaments. Indeed, Gutshall is primarily concerned with forming a screw from a blank.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438, 1442 (Fed. Cir.1991).

In the instant case, there is no teaching nor suggestion in the cited prior art patents for use of a connection part which comprises screw thread at one end of a stalk member of an artificial

ornament which engages a resiliently flexible connection means to interconnect a head member to the stalk member. Moreover, there is no teaching of any incentive for such a modification. Any suggestion of obviousness could only result if the PTO reads the subject matter of the present invention into the cited references, where no such disclosure exists. In particular, the only way to make such a rejection of those claims would be to impermissibly use the Applicant's own teaching to hunt through the prior art for the claimed elements and combine them as claimed, an action which is impermissible. See Vaeck, *supra*.

Moreover, it is an accepted principle of patent law that the PTO may not "use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 USPQ 1780, 1784 (Fed. Cir. 1992).

Accordingly it is respectfully submitted that the subject matter of Claim 1 is not rendered obvious by the Bowen patent together with the Gutshall patent.

Another reason that Claim 1 is patentable over the cited art is that Bowen requires a shaped pin which will prevent the rotation of a spirally curved wire placed thereon. In particular, Bowen states that the tapering pin may be:

" . . . of any suitable shape . . . in order to prevent the . . . attached portions from turning after being placed in position." (see the seventh paragraph of page 2)

It is noted that the self-tapping screws of Gutshall have substantially cylindrical shanks with a tapered end portion only (as one would expect with a self-tapping screw). The tapered

portion is not sufficiently dimensioned to allow secure location of a spirally curved wire of Bowen. For secure location the wire would have to be wound onto the cylindrical shank of the screw of Gutshall. This would not fall within the teaching of Bowen since, presumably, it would allow rotation of the attached part about the principle axis of the shank. Indeed, that is exactly the purpose of a screw - to allow and encourage, relative rotation of a workpiece about the principle axis thereof.

Therefore, even if, which is not admitted, a skilled person were to make a leap of faith (as required by the subject rejection) and consider combining the teachings of Bowen and Gutshall, that person would realize that the combination would not satisfy the teachings of Bowen because it would not provide for secure location of a spirally curved wire. Moreover, if the person skilled in the art were to modify the disclosure of Bowen by providing a tapering projection pin having a screw-thread according to Gutshall, the projection pin would have sharp crests (see, for example, line 59 of column 1). This would clearly be disadvantageous during installation of a garden ornament as the installer could, for instance, cut his finger on the sharp edges. Thus, there is a positive disincentive to combine Bowen with Gutshall.

The arguments set out above apply *mutatis mutandis* to amended Claim 1. It is therefore submitted that amended Claim 1 is allowable.

Claims 2 - 5 and 7 - 15 depend directly or indirectly from Claim 1. Hence it is respectfully submitted that these claims are also allowable. It should also be pointed out that the patent to Chance fails to make up for the deficiencies of Bowen and Gutshall as viable references, since all Chance discloses is the use of a spring to be made of stainless steel for anchoring a candle to the

interior of a jack-o-lantern. Chance, like Bowen, does not teach nor suggest the use of a screw thread at one end of a stalk member of an artificial ornament which engages a resiliently flexible connection means to interconnect a head member to the stalk member.

Independent Claim 17 is directed to a method of forming a the structure like that set forth in Claim 1. Thus, for the same basic reasons as given with respect to Claim 1, it is respectfully submitted that Claim 17 is patentable over the art of record. Moreover, Independent Claims 17 has been amended to call for the ornament to be in the shape of a fungus, rather than in the shape of a fungus or a plant. This feature is not shown in Bowen, Gutshall or Chance.

Independent Claim 18 is directed to a kit of parts for an artificial garden ornament like that set forth in Claim 1. Thus, for the same basic reasons as given with respect to Claim 1, it is respectfully submitted that Claim 18 is patentable over the art of record. In addition, Claim 18 has been amended in a similar manner to Claim 17, i.e., to call for the ornament to be in the shape of a fungus, rather than in the shape of a fungus or a plant.

Independent Claim 19 is directed to an ornament like that set forth in Claim 1. Thus, for the same basic reasons as given with respect to Claim 1, it is respectfully submitted that Claim 19 is patentable over the art of record. In addition, Claim 19 has been amended in a similar manner to Claims 17 and 18, i.e., to call for the ornament to be a fungus, rather than a fungus or a plant.

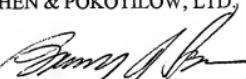
For at least the reasons set forth above, it is respectfully submitted that Claims 1 - 5 and 7-19, all of the claims now appearing in this application are allowable and that the application is in condition for allowance and such action is respectfully requested.

Application No. 10/763,798
Amendment Dated September 14, 2006
Reply to Final Office Action of June 19, 2006

Should the Examiner believe that anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

CAESAR, RIVISE, BERNSTEIN,
COHEN & POKOTILOW, LTD.

By 

Barry A. Stein
Registration No. 25,257
Customer No. 03000
(215) 567-2010
Attorneys for Applicant

September 14, 2006

Please charge or credit our Account No.
03-0075 as necessary to effect entry
and/or ensure consideration of this
submission.